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PAGE: 001**BROWN RAYSMAN**BROWN RAYSMAN MILLSTEIN FELDER & STEINER[®]**FACSIMILE COVER SHEET**

From:	Steven S. Rubin	Date:	February 28, 2005
Direct Dial:	212-895-2009	Client/Matter #:	5598/68

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1.	Examiner Jason M. Borlinghaus	USPTO - Group Art Unit 3621	703-872-9306	703-308-9552

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MESSAGE:

ATTORNEY DOCKET NO. 5598/68

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Flake

Examiner:

Borlinghaus, Jason M

Serial No.: 10/625,001

Group Art Unit:

3628

Filed: July 22, 2003

Title: TERM-BASED CONCEPT INSTRUMENTS

CENTRAL FAX CENTER
FEB 28 2005Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Office Action issuing an election of species dated January 27, 2005, Applicant provisionally elects claims 1 and 13 and the species designated "5" in the Office Action with traverse. This election is made without admission, and Applicant reserves the right to pursue the subject matter of the non-elected claims in one or more continuing applications.

Applicant respectfully asserts that a valid species election requirement has not been made. "There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02)." M.P.E.P. §803.

“Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions as claimed are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween . . . “ M.P.E.P. §808. The Examiner must set forth his reasons for holding that inventions are independent or distinct. M.P.E.P. § 816.

“Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.” MPEP 806.04(f).

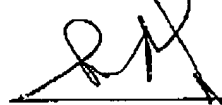
“Where two or more related inventions are being claimed, the principal question to be determined in connection with a requirement to restrict . . . is whether or not the inventions as claimed are distinct. If they are distinct, restriction may be proper. If they are not distinct, restriction is never proper.” MPEP 806.05.

The Examiner has simply set forth no reasoning for the elections shown in page 2 of the Office Action. There is no discussion of any serious burden on the Examiner – as is required under M.P.E.P. §803.01. There is no discussion of the reasons why the inventions as recited in the respective claims are either independent or distinct - as is required under M.P.E.P. §§808 and 816. There is no discussion of the type of various parings available of related inventions – as is detailed in M.P.E.P §§806.05(a) – 806.05(i). Finally, there is no assertion relating to mutual exclusivity – as is required under M.P.E.P. §806.04(f).

As such, the Examiner has not set forth a prima facie showing of a valid species election requirement and therefore Applicant is not obligated to elect any one of the suggested species. In light of the above, Applicant requests that the Examiner issue a Restriction Requirement in accordance with the M.P.E.P., a substantive Office Action on the pending claims, or a Notice of Allowance.

Dated: 2/28/05

Respectfully submitted,



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I hereby certify that this paper is being deposited this date as a facsimile sent to Jason M. Borlinghaus, an Examiner in Art Unit 3628 of the United States Patent and Trademark Office at facsimile number: (703) 872-9306.


Annette Mejia

2/28/05
Date

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